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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/771,095
Filing Date: January 26, 2001
Appellant(s): KONETSKI ET AL.

Konetski, David et al
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/04/2008 appealing from the Office action mailed 04/14/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,073,199	**RALEY**	**7-2006**
6,987,221	**Platt**	**1-2006**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 27, 29 – 46, and 48 - 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael Charles Raley (US 7073199; hereinafter Raley) in view of John C. Platt (US 6,987,221; hereinafter Platt).

Regarding claims 27, 40, and 46, Raley teaches a personal computer comprising a processor and a memory (col. 2, line 62 through col. 3, line 13) for retrieving digital media from a content provider, wherein the retrieving is performed by a

processor of a personal computer (col. 7, lines 27 - 38); performing a digital rights management function associated with an authorized user resulting in authorized digital media content, wherein the digital rights management function is performed by the processor of the personal computer (col. 7, line 38 through col. 8, line 2); storing the authorized digital media content in a memory of the personal computer (col. 8, lines 2 - 14); and providing the authorized digital media content via a user interface to a thin media client without performing a digital rights management function on the thin media client, wherein the providing is performed by the personal computer (col. 8, line 53 through col. 9, line 9).

Raley teaches substantially all the limitations, but fails to specifically teach that the thin media client comprises an input/output (IO) device coupled to the personal computer.

However, Platt teaches an analogous auto playlist generation with multiple seed songs, wherein the thin media client comprises an input/output (IO) device coupled to the personal computer (col. 17, lines 5 – 27).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Raley by incorporating an input/output (IO) device coupled to the personal computer in the thin client media as evidenced by Platt for the purpose of allowing user(s) to generate or regenerate playlists, thereby providing a user friendly device.

Regarding claims 29 and 48, Raley and Platt teach all the limitations in claims 27 and 46, and Raley further teaches that the personal computer comprises a laptop computer (col. 9, lines 60 – 64; Raley discloses a portable computer).

Regarding claims 30 and 49, Raley and Platt teach all the limitations in claims 27 and 46, and Raley further teaches that the content provider comprises a server reachable by the computer system over a network (col. 8, lines27 - 29).

Regarding claims 31 and 51, Raley and Platt teach all the limitations in claims 27 and 46, and Raley further teaches that the content provider comprises a local input device (col. 1, line 49 – 61; col. 2, lines 55 - 61).

Regarding claims 32 and 33, Raley and Platt teach all the limitations in claims 27 and 46, and Platt further teaches that the content provider comprises a USB, and a CD-ROM (col. 17, lines 5 – 27). The motivation recited above, also applies to claims 32 and 33.

Regarding claims 34 and 50, the Examiner takes Official Notice that using a Bluetooth to receive authorized digital media content is well known in the art.

Regarding claims 35 and 36, Raley teaches the system of claim 27, wherein the thin media client comprises an audio client; and wherein the digital media content comprises an audio file (col. 10, lines 10 - 18).

Regarding claims 37, the Examiner takes Official Notice that having digital media content comprises realtime audio information is well known in the art.

Regarding claims 38 – 39, Raley and Platt teach all the limitations in claim 27, and Raley further teaches that the thin media client comprises a video client, and

wherein the digital media content comprises video information; and wherein the thin media client comprises an image client, and wherein the digital media content comprises image information (col. 10, lines 10 - 18).

Regarding claim 41, Raley and Platt teach all the limitations in claim 40, and Raley further teaches that the organization functions allow a user to set preferences associated with a client (col. 9, lines 29 – 36; Raley discloses that the contents of the set of rights may be determined based on the document, the user's identity, a payment made by the user, **or any other parameter**).

Regarding claim 42, Raley teaches substantially all the limitations in claim 40, but fails to specifically teach that the organization functions allow a user to set preferences associated with a client create playlist of stored organized digital media content.

However, Platt teaches an analogous auto playlist generation with multiple seed songs, which allows a user to create a playlist of stored organized digital media content (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Raley by incorporating an organization functions that allow a user to create playlists of stored organized digital media content as evidenced by Platt for the purpose of permitting user(s) to select different moods and/or styles (e.g., dance music, classical, big band, country, heavy metal and the like), thereby allowing a playlist that meets user's preferences.

Regarding claim 43, Raley and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to manage a favorites list of

organized digital media content (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 42 also applied for claim 43.

Regarding claim 44, Raley and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to manage the amount of organized digital media stored on the computer system (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 42 also applied for claim 44.

Regarding claim 45, Raley and Platt teach all the limitations in claim 40, and Platt further teaches that the organization functions allow a user to select digital media content to be retrieved (col. 1, lines 12 – 67; col. 2, lines 16 – 36; col. 4, lines 4 – 11 and lines 45 - 50). The motivation in claim 41 also applied for claim 45.

(10) Response to Argument

In response to appellant's argument (page 6) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Raley discloses a method and apparatus for controlling various rights in, and access to, the content of documents displayed with the rendering engine, which comprises all the limitations as claimed (see above rejection), except for the idea of the media client

comprising an input/output (I/O) device coupled to the personal computer. Platt further discloses such limitation (see col. 17, lines 5 – 27) for the purpose of allowing user(s) to generate or regenerate playlists, thereby providing a user friendly device.

Regarding Appellant's argument (page 7, third paragraph), that Platt fails to teach "the thin media "comprising an input/output (I/O) device coupled to the personal computer. The Examiner respectfully disagrees with Appellant's assertion because Raley teaches having a " thin client " and Platt was cited for the idea of having an input/output (I/O) device coupled to the personal computer (see again col. 17, lines 5 – 27). Platt further discloses that the systems and methods described herein can be utilized with a variety of suitable components (e.g., software and/or hardware) and devices and still be in accordance with the present invention. Suitable components and devices include MP3 players, DVD players, portable DVD players, CD players, portable CD players, video compact disk (VCD) players, super video compact disk (SVCD) players, electronic book devices, **personal digital assistants (PDA**), computers, car stereos, **portable telephones** and the like. Thus, Platt does teach the "thin media client " as claimed (see col. 1, lines 12 – 23; col. 18, lines 14 - 23).

In response to Appellant's argument that it is clear that neither the computer 1512, nor the remote computer 1544 of Platt teach a thin media client, as recited in the pending claims and defined throughout the specification and figures of the pending application. The Examiner respectfully disagrees with Appellant's assertion because Platt does disclose personal digital assistants (PDA), portable telephones such as "thin client media "(see col. 1, lines 12 – 23; col. 18, lines 14 – 23).

Thus, in view of the passages cited above, the combine references do read on the claimed subject matter.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Yves Dalencourt/

Primary Examiner, Art Unit 2457

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/Salad Abdullahi/

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